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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,406	04/01/2004	Jeffrey C. Hawkins	24772-10754	7979
758	7590	09/06/2006	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				RAMPURIA, SHARAD K
		ART UNIT		PAPER NUMBER
				2617

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/815,406	HAWKINS, JEFFREY C.	
	Examiner	Art Unit	
	Sharad Rampuria	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 July 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-9,12-15,20-23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-9,12-15,20-23 and 25-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

I. The Art Unit location of this application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Continued Examination Under 37 CFR 1.114

II. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/29/2006 has been entered.

The current office-action is in response to the amendments filed on 07/26/2006.

Accordingly, Claims 2-3, 10-11, 16-19, and 24, 36 are cancelled. Claims 1, 4-9, 12-15, and 20-23, 25-35 are pending for further examination as follows:

Claim Rejections - 35 USC § 102

III. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes

of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 7-9, 12-15, and 20-23, 25-35 are rejected under 35 U.S.C. 102 (e) as being anticipated by Warren [US 6999792].

As per claim 1, Warren teaches:

A peripheral device (10; Fig.1) for operation in conjunction with a handheld wireless communication device (12; Fig.1), the peripheral device (Abstract, Col.4; 15-24) comprising:

An alphanumeric keyboard (16; Fig.1, Col.4; 25-35) operable to receive user input data; (Col.4; 25-35)

A communication interface (28; Fig.1) operable to a communication interface operable to receive first data from the handheld wireless communication device and transmit second data to the handheld wireless communication device, the first and second data being interactable by an application on the handheld wireless communication device. (Col.3; 4-22, Col.4; 50-Col.5; 7, Col.9; 51-67, Col.4; 36-43, Col.6; 61-Col.7; 8)

A screen (20; Fig.1, Col.4; 25-35) to display at least part of the first and second data; (Col.4; 25-35, 44-48) and

A processor (36; Fig.2) coupled to the alphanumeric keyboard, the communication interface, and the screen, operable to execute a peripheral application using the user input data and the first data thereby generating the second data; (Col.5; 62-Col.6; 10)

The peripheral application being associated with the application on the handheld wireless communication device. (i.e. access information; Col.3; 4-22, Col.4; 44-62, Col.9; 51-67).

As per claim 5, Warren teaches:

The peripheral device of claim 1, further comprising a backup memory, operably coupled to the communication interface, for storing a backup copy of the first data. (Col.6; 36-38)

As per claim 7, Warren teaches:

The peripheral device of claim 1, wherein said communication interface further transmits a signal to said handheld wireless communication device directing said handheld wireless communication device to transmit at least one data item and a data request via a network connection. (i.e. internent; Col.4; 36-43, Col.9; 51-67)

As per claim 8, Warren teaches:

The peripheral device of claim 1, wherein said communication interface further receives a signal from said handheld wireless communication device representing at least one data item received by said handheld wireless communication device via a network connection. (i.e. internent; Col.4; 36-43, Col.9; 51-67)

As per claim 9, Warren teaches:

The peripheral device of claim 7, wherein said communication interface further transmits a signal to said wireless communication device directing said wireless communication device to transmit at least one data item and a data request via the Internet. (i.e. internent; Col.4; 36-43, Col.9; 51-67)

As per claim 12, Warren teaches:

The peripheral devise of claim 6, further comprising an enclosure having an opened position and a closed position, wherein said predetermined event for establishing connectivity is the transition of said enclosure from said closed position to said open position. (Col.4; 15-24 and abstract)

As per claim 13, Warren teaches:

The peripheral device of claim 6, wherein said predetermined event for establishing connectivity is a signal transmitted by said handheld wireless communication device. (i.e. access information; Col.3; 4-22, Col.4; 44-62, Col.9; 51-67)

As per claim 14, Warren teaches:

The peripheral device of claim 1, wherein said second data is stored in a storage medium on said peripheral device. (i.e. memory, 38; Fig.2; Col.5; 62-65)

As per claim 15, Warren teaches:

The peripheral device of claim 1, wherein said processed data is stored in a storage medium on said wireless communication device. (i.e. memory, 38; Fig.2; Col.5; 62-65)

As per claim 20, Warren teaches:

The peripheral device of claim 1, further comprising a network interface, coupled to said processor, for transmitting at least one of a data item and a data request via a network connection, and for receiving at least one data item via said network connection. (i.e. internent; Col.4; 36-43)

As per claim 21, Warren teaches:

The peripheral device of claim 1, wherein said communication interface further receives, from said wireless communication device, software code for at least one software application. (Col.4; 44-62)

As per claim 22, Warren teaches:

The peripheral device of claim 1, further comprising memory for storing the first data and the second data. (i.e. memory, 38; Fig.2; Col.5; 62-65)

As per claim 23, Warren teaches:

The peripheral device of claim 22, wherein said memory stores said first data and said second data from one user session to at least one subsequent user session. (Col.4; 44-62)

As per claim 25, Warren teaches:

A peripheral device (10; Fig.1) for a handheld computing system (Abstract, Col.4; 15-24), the peripheral device comprising:

A communication interface (28; Fig.1) structured to receive first data from the handheld computing system and transmit second data to the handheld computing system, wherein the first data and the second data are interactable by a handheld application on the handheld computing system, (Col.3; 4-22, Col.4; 50-Col.5; 7, Col.9; 51-67, Col.4; 36-43, Col.6; 61-Col.7; 8)

A display (20; Fig.1, Col.4; 25-35) communicatively coupled with the communication interface and structured to visually present at least part of the first data and the second data;

An alphanumeric keyboard (16; Fig.1, Col.4; 25-35) hingedly coupled with the display and structured to receive an a user input, the user input being for manipulating the first data; and

A processor (36; Fig.2) coupled to the communication interface, the alphanumeric keyboard, and the display and configured to execute a peripheral application using the user input and the first data thereby generating the second data (Col.5; 62-Col.6; 10), the peripheral application being associated with the handheld application on the handheld computing. (i.e. access information; Col.3; 4-22, Col.4; 44-62, Col.9; 51-67).

As per claim 26, Warren teaches:

The peripheral device of claim 25, wherein the display comprises graphics processor for rendering full-screen display. (10; Fig.2, Col.4; 63-67)

As per claim 27, Warren teaches:

The peripheral device of claim 25, wherein the alphanumeric keyboard comprises a QWERTY keyboard. (16; Fig.1, Col.4; 25-35)

As per claim 28, Warren teaches:

The peripheral device of claim 25, further comprising a processor configured to process the visually presented data prior to transmitting the second data to the handheld computer system. (10; Fig.2, Col.4; 63-67)

As per claim 29, Warren teaches:

The peripheral device of claim 25, further comprising a memory to temporarily store the visually presented data. (10; Fig.2, Col.4; 63-67)

As per claim 30, Warren teaches:

The peripheral device of claim 25, further comprising a storage medium configured to store data. (i.e. memory, 38; Fig.2; Col.5; 62-65)

As per claim 31, Warren teaches:

The peripheral device of claim 30, wherein the storage medium comprises a solid state storage medium. (i.e. memory, 38; Fig.2; Col.5; 62-65)

As per claim 32, Warren teaches:

The peripheral device of claim 25, wherein the communication interface comprises a Bluetooth communication interface. (Col.6; 33-36)

As per claim 33, Warren teaches:

The peripheral device of claim 25, wherein the communication interface comprises a tethered communication interface. (Col.6; 33-36)

As per claim 34, Warren teaches:

The peripheral device of claim 25, further comprising a power management module configured to instantly place the display and the alphanumeric keyboard in an instant on state or an instant off state. (40; Fig.2, Col.5; 63-65)

As per claim 35, Warren teaches:

The peripheral device of claim 25, wherein the handheld computing system comprises a personal digital assistant. (10; Fig.2, Col.5; 41-50)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4 & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren in view of Guerlin et al. [US 5870680].

As per claim 4, Warren teaches all the particulars of the claim except peripheral device automatically turns on in response to at least one predefined event. However, Guerlin teaches in an analogous art, that the peripheral device of claim 1, wherein said peripheral device automatically turns on in response to at least one predefined event. (i.e. When it has not received any scanning messages in a predetermined time interval, the microprocessor 240 in the microcomputer 2 commands the activity controller 242 via the bus Bca' to deactivate/activate the clock circuits timing the microprocessor 240 and the interface circuit 25; Col.6; 17-28, Col.7; 1-8) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Warren including peripheral device automatically turns on in response to at least one predefined event in order to provide making provision for placing the microprocessors and the input-output interface circuits in the mobile telephone and the microcomputer on standby.

As per claim 6, Warren teaches all the particulars of the claim except communication interface is adapted to automatically establish connectivity with said peripheral device in response to at least one predefined event. However, Guerlin teaches in an analogous art, that the

peripheral device of claim 1, wherein said communication interface is adapted to automatically establish connectivity with said peripheral device in response to at least one predefined event. (i.e. When it has not received any scanning messages in a predetermined time interval, the microprocessor 240 in the microcomputer 2 commands the activity controller 242 via the bus Bca' to deactivate/activate the clock circuits timing the microprocessor 240 and the interface circuit 25; Col.6; 17-28, Col.7; 1-8).

Response to Amendments & Arguments

IV. *Applicant's arguments filed on 7/26/2006 have been fully considered but they are not persuasive.*

Relating to Claim 1:

In comeback to Applicant's dispute that Warren doesn't teach, "A communication interface operable to a communication interface operable to receive first data from the handheld wireless communication device and transmit second data to the handheld wireless communication device, the first and second data being interactable by an application on the handheld wireless communication device." it is noted that the Examiner respectfully asserts that the cited art, is legally efficient for the purpose of rendering claim unpatentable. In particular, Warren supports the allegation as, a user can easily enter information (such as a web site address or an email message) by the keyboard (instead of by a mini-keypad of a web phone), easily view text and/or graphics (from web pages or email messages) on the screen (instead of on a mini-

screen of a web phone), and easily access information (such as appointment calendar entries) stored on a home or other remote computer. (Please perceive Col.3; 4-22, Col.4; 50-Col.5; 7, Col.9; 51-67, Col.4; 36-43, Col.6; 61-Col.7; 8, Col.1; 65-Col.2; 11), therefore, Warren explained the application, for example, email message can be interactable on the portable phone and it can be easily view on the display of the peripheral device that means the extension of the application to the peripheral device, which certainly read on the applicant's invention. At the same time as in support; "the examiner must give the broadest reasonable interpretation to all claims presented."

As stated in MPEP § 2111 - § 2111.01. Hence, it is believed that ***Warren still teaches the claimed limitations.***

In view of the fact that, Warren still teaches the claimed limitations, the combination of Guerlin with Warren still teaches the claimed limitations as explained above.

Because claims 5, 7-9, 12-15, and 20-23 are dependent on claim 1, and claims 26-35 are dependent on claim 25, consequently the response is the same explanation as set forth above with regard to claims 1, 25, respectively.

With the intention of that explanation, it is believed and as enlighten above, the refutation are sustained.

Conclusion

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is (571) 272-7870. The examiner can normally be reached on M-F. (8:30-5 EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or EBC@uspto.gov.



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